

## **REMARKS**

### **I. STATUS OF APPLICATION**

Claims 7-27 are pending in the present application. No claims have been amended, added, or canceled in this paper.

Applicant acknowledges with appreciation the indication in the Office Action that independent claim 27 is allowed.

Claims 7, 18, and 19 stand rejected under 35 USC § 102(b), as being anticipated by U.S. Patent 5,147,067 to Effertz ("Effertz") and U.S. Patent 4,648,525 to Henderson ("Henderson").

Claims 7, 18, and 19 stand rejected under 35 USC § 102(b), as being anticipated by U.S. Patent 1,736,383 to Waggoner ("Waggoner").

Claims 9-12, 20, and 24-26 stand rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of U.S. Patent 5,564,568 to Rankin, Sr. ("Rankin").

Claim 13 stands rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Rankin and U.S. Patent Application Publication 2002/0036206 to Bergman *et al.* ("Bergman").

Claim 14 stands rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of U.S. Patent 5,985,383 to Allen *et al.* ("Allen").

Claim 15 stands rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of 1,395,485 to Duncan *et al.* ("Duncan").

Claims 16 and 17 stand rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Duncan and U.S. Patent 6,510,627 to Liu ("Liu").

Claims 21-23 stand rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Rankin, Duncan, Liu, and Allen.

## **II. 35 USC § 102 REJECTIONS**

### **A. CLAIMS 7, 18, AND 19 ARE ALLOWABLE OVER EFFERTZ AND HENDERSON**

Claims 7, 18, and 19 stand rejected under 35 USC § 102(b), as being anticipated by Effertz and Henderson. The rejection is respectfully traversed because (1) the Office Action is unclear as to whether claims 7, 18, and 19 are rejected over Effertz and Henderson separately or in combination; (2) the Office has failed in its burden to identify wherein each and every facet of the claimed invention is disclosed in the applied references; and (3) neither Effertz nor Henderson, whether taken singly or in combination anticipate the invention set forth in the rejected claims.

#### **1. The Office Action is unclear as to whether claims 7, 18, and 19 are rejected over Effertz and Henderson separately or in combination**

The Office Action merely alleges that “[c]laims 7, 18, and 19 are rejected under 35 USC § 102(b) as being anticipated by Effertz and Henderson.”<sup>1</sup> “It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.”<sup>2</sup> Applicant respectfully asserts that the Office has failed in this burden because it is unclear as to whether claims 7, 18, and 19 are rejected over Effertz and Henderson separately or in combination.

---

<sup>1</sup> Detailed Action, p.2, II. 7-8.

<sup>2</sup> *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) quoting *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1788-89 (Bd. Pat. App. & Int. 1987).

If claims 7, 18, and 19 are rejected over a combination of Effertz and Henderson, MPEP 2131.01 instructs:

*Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:*

- (A) Prove the primary reference contains an "enabled disclosure;"*
- (B) Explain the meaning of a term used in the primary reference; or*
- (C) Show that a characteristic not disclosed in the reference is inherent.*

The Office Action, however, fails to provide any indication that either Effertz or Henderson is being employed for any of these reasons.

Accordingly, Applicant respectfully asserts that the rejection of claims 7, 18, and 19 is *prima facie* deficient because the rejection is unclear as to whether claims 7, 18, and 19 are rejected over Effertz and Henderson separately or in combination. Moreover, if claims 7, 18, and 19 are rejected over a combination of Effertz and Henderson, the rejection is *prima facie* deficient because neither Effertz nor Henderson are used to prove the primary reference contains an "enabled disclosure;" explain the meaning of a term used in the primary reference, or show that a characteristic not disclosed in the primary reference is inherent.

For at least these reasons, the rejection of claims 7, 18, and 19 under 35 USC § 102(b), as being anticipated by Effertz and Henderson, should be reconsidered and withdrawn.

**2. The Office has failed in its burden to identify wherein each and every facet of the claimed invention is disclosed in the applied references**

"[I]t is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."<sup>3</sup> The Office, however, baldly asserts that claims 7, 18, and 19 are "clearly anticipated by Effertz and Henderson."<sup>4</sup> Applicant respectfully asserts that the Office has failed in its burden to identify wherein each and every facet of the claimed invention, set forth in claims 7, 18, and 19, is disclosed in Effertz and Henderson. Accordingly, for at least this additional reason, the rejection is *prima facie* deficient and should be withdrawn.

**3. Neither Effertz nor Henderson, whether taken singly or in combination, discloses the claimed invention**

Independent claim 7 recites "means for **urging** the first edge and the second edge toward one another" (emphasis added). As noted above, the Office has not provided any insight as to how the cited references are to be applied. Effertz discloses an insulating strip 5 having tabs 8 and 9. Velcro<sup>®</sup> strips 11 and 12 are disposed on tabs 9 and 8, respectively. Effertz teaches the operation of insulating strip 5:

*To apply my insulating strip 5 to a beverage can 13, I apply the end of the strip 5 having tab 8 to the can first with the Velcro strip 12 facing outwardly away from the can. I then wrap the remainder of the strip tightly around the body of the can intermediate its ends and bring the tab 9 into overlapping and interlocking relation with tab 8 to thereby secure the strip 5 in encircling and insulating relation to the can 11*

(emphasis added).<sup>5</sup>

---

<sup>3</sup> *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

<sup>4</sup> Detailed Action, p. 2, ll. 7-8.

<sup>5</sup> Effertz, col. 3, ll. 16-23.

Applicant respectfully asserts that Effertz fails to disclose or suggest any apparatus having a means for urging a first edge and a second edge toward one another, as alleged by the Office. Velcro<sup>®</sup> strip 11 interfaces with Velcro<sup>®</sup> strip 12 to **retain or hold** tab 9 in relation to tab 8. Velcro<sup>®</sup> strips 11 and 12, however, do not urge any element of Effertz toward another other element of Effertz.

An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim.<sup>6</sup> Applicant respectfully submits that Effertz falls short of this standard, because Effertz is silent with regard to a means for urging a first edge and a second edge toward one another, as required by independent claim 7. For at least this reason, independent claim 7 is allowable over Effertz.

Henderson discloses a holder 20 made from a sheet 22 of insulative foam. Sheet 22 includes a main body portion 25 having two opposite side edges 26L and 26R joined together by seam tape 27.<sup>7</sup> Thus, seam tape 27 **retains or holds** edges 26L and 26R together or at least proximate one another. Seam tape 27, however, does not **urge** edges 26L and 26R toward one another. For Henderson to anticipate Applicant's invention set forth in claim 7, Henderson would necessarily have to teach some means by which edges 26L and 26R are urged toward one another. Instead, a person having ordinary skill in the art at the time of the invention would appreciate that a person or machine, **separate from Henderson's beverage container**, would necessarily have to

---

<sup>6</sup> *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

<sup>7</sup> Henderson, col. 2, ll. 47-52.

position edges 26L and 26R prior to applying seam tape 27 to ***hold or retain*** edges 26L and 26R in their desired positions.

As Henderson fails to disclose every limitation of rejected claim 7 in the same relationship to one another as set forth in claim 7, Henderson cannot anticipate the invention set forth in claim 7. For at least this reason, claim 7 is allowable over Henderson.

Even if one were to combine the teachings of Effertz and Henderson, claim 7 is still not anticipated by Effertz and Henderson. As can be seen from the discussion above, neither Effertz nor Henderson, whether taken singly or in combination, disclose every limitation of rejected claim 7 in the same relationship to one another as set forth in claim 7.

Claims 18 and 19 depend from claim 7. Accordingly, the remarks provided above concerning claim 7 apply equally to claims 18 and 19.

It is, therefore, respectfully requested that the rejection of claims 7, 18, and 19 under 35 USC § 102(b), as being anticipated by Effertz and Henderson, be reconsidered and withdrawn.

#### **B. CLAIMS 7, 8, 18, AND 19 ARE ALLOWABLE OVER WAGGONER**

Claims 7, 8, 18, and 19 stand rejected under 35 USC § 102(b), as being anticipated by Waggoner. The rejection is respectfully traversed because Waggoner fails to disclose each and every limitation of the rejected claims in the same relationship set forth in the rejected claims, as discussed below.

# **1. Waggoner does not teach an apparatus for insulating a beverage container**

Independent claim 7 recites “[a]n apparatus for insulating a beverage container.” The Office baldly asserts that “Waggoner discloses an apparatus capable of insulating a beverage container” without providing any explanation as to how Waggoner’s linoleum jacket would achieve such a feat.<sup>8</sup> Waggoner discloses a linoleum jacket “especially adapted for use in connection with the packing for shipments of linoleum and has for its primary object the provision of a protective covering which may be used in lieu of the ordinary well known heavy crate or boxing.”<sup>9</sup> Waggoner neither discloses nor suggests any characteristic of its linoleum jacket that is insulating. Waggoner neither discloses nor suggests, in any way, that its linoleum jacket can be used as a beverage container. Moreover, a person having ordinary skill in the art at the time of the invention would not have appreciated that Waggoner’s linoleum jacket, or the sheet member 6 of the linoleum jacket, has any insulating properties or could be used as a beverage container. Accordingly, Waggoner fails to disclose each of the limitations of rejected claim 7 in the same relationship set forth in claim 7. Thus, Waggoner cannot anticipate the invention set forth in claim 7.

Because Waggoner fails to disclose any insulating characteristic of its linoleum jacket, it appears that the Office is alleging that Waggoner’s linoleum jacket is *inherently* insulating. Where anticipation is found through inherency, the Office's burden of establishing *prima facie* anticipation includes the burden of providing "...some evidence

---

<sup>8</sup> The Office is reminded of its burden to “identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

<sup>9</sup> Waggoner, p. 1, ll. 2-7.

or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art."<sup>10</sup> ***No such evidence, however, has been provided.*** Inherency in anticipation requires that the asserted proposition *necessarily* flow from the disclosure.<sup>11</sup> ***Waggoner provides no teaching that its linoleum jacket can provide insulating benefits.*** It is not enough that a reference could have, should have, or would have been used as the claimed invention. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient."<sup>12</sup> "Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."<sup>13</sup> ***Applicant respectfully asserts that construing Waggoner's linoleum jacket as being insulating is based solely on speculation rather than Waggoner's disclosure.***

For at least these reasons, the rejection of claim 7 under 35 USC § 102(b), as being anticipated by Waggoner, should be reconsidered and withdrawn.

## **2. Waggoner's linoleum jacket does not define a cavity adapted to receive a beverage container**

Waggoner fails to disclose in any way that its linoleum jacket defines a cavity "adapted to receive the beverage container," as required by claim 7. It should be noted that the Office fails to identify how Waggoner's linoleum jacket defines a cavity adapted to receive a beverage container. If for no other reason than this, the rejection is *prima*

---

<sup>10</sup> *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1789 (Bd. Pat. App. & Int. 1987).

<sup>11</sup> *In re Oelrich*, 212 U.S.P.Q. (BNA) 323, 326 (C.C.P.A. 1981); *Levy*, 17 U.S.P.Q.2d (BNA) at 1463-64; *Skinner*, at 1789; *In re King*, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986).

<sup>12</sup> *Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. (BNA) 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d (BNA) 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789.



*facie* deficient.<sup>14</sup> As noted above, an anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim.<sup>15</sup> A linoleum jacket that is “adapted for use in connection with the packing for shipments of linoleum” is not adapted to receive a beverage container. Because Waggoner fails to disclose every limitation of claim 7 in the same relationship to one another as set forth in claim 7, Waggoner cannot anticipate claim 7.

Claims 8, 18, and 19 depend from claim 7. Accordingly, the remarks provided above concerning claim 7 apply equally to claims 8, 18, and 19.

For at least the reasons provided herein, the rejection of claims 7, 8, 18, and 19 under 35 USC § 102(b), as being anticipated by Waggoner, should be reconsidered and withdrawn.

### **III. 35 USC § 103 REJECTIONS**

#### **A. CLAIMS 9-12, 20, AND 24-26 ARE ALLOWABLE OVER WAGGONER IN VIEW OF RANKIN**

Claims 9-12, 20, and 24-26 stand rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Rankin. This rejection is respectfully traversed because (1) Waggoner fails to disclose or suggest the claimed limitations alleged by the Office; (2) Waggoner is outside the scope and content of the prior art; and (3) even if Waggoner and Rankin were to be combined, the result would not be Applicant's claimed invention.

---

<sup>13</sup> *Skinner* at 1789, citing *Oelrich* at 581.

<sup>14</sup> The examiner has the burden to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See *Levy* at 1462.

<sup>15</sup> *In re Bond* at 1567.

**1. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container**

In an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.<sup>16</sup> Regarding claims 9-12, Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container, as discussed above concerning the 35 USC § 102(b) rejection of claim 7, from which claims 9-12 depend. Regarding claims 9-12, 20, and 24-26, Waggoner is completely silent with regard to any insulating properties of its linoleum jacket. Waggoner fails to even suggest the desirability of its linoleum jacket having insulating properties. Thus, irrespective of the teaching of Rankin, claims 9-12, 20 and 24-26 are allowable over Waggoner and Rankin for at least these same reasons. Accordingly, Waggoner and Rankin cannot render claims 9-12, 20, and 24-26 obvious.

**2. Waggoner is outside the scope and content of the prior art**

Applicant respectfully asserts that Waggoner is outside the scope and content of the prior art. As previously mentioned, Waggoner concerns a linoleum jacket as opposed to any kind of apparatus for insulating a beverage container. Thus, it can be within the scope and content of the prior art only if it is “reasonably pertinent” to Applicant’s invention:

*A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s*

---

<sup>16</sup> *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

*attention in considering his problem. Thus, the purposes of both the inventor and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have less motivation or occasion to consider it.*<sup>17</sup>

In the present case, the linoleum jacket of Waggoner addresses a very different problem for a very different purpose. Waggoner states its intent and interest directly in the patent (emphasis added):

*This invention relates to a wrapping jacket especially adapted for use in connection with the **packing for shipments** of linoleum and has for its primary object the provision of a **protective covering which may be used in lieu of the ordinary well known heavy crate or boxing.***<sup>18</sup>

\*\*\*\*\*

*Another object of my invention is the contemplation of a **shipping jacket which may be used over and over and which is returnable at a minimum cost the factory making the shipment.***<sup>19</sup>

\*\*\*\*\*

*...the numeral 5 designates a **roll of linoleum which is being encased for shipment through the use of a jacket made in accordance with the preferred form of my invention.***<sup>20</sup>

None of these are even remote considerations in Applicant's invention.

---

<sup>17</sup> *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (reversing Board holding of obviousness).

<sup>18</sup> Waggoner, p. 1, ll. 1-7.

<sup>19</sup> Waggoner, p. 1, ll. 8-12.

Thus, practical considerations in operation and structure of the claimed invention, an apparatus for insulating a beverage container, and Waggoner, a linoleum jacket, evidence the distinctiveness of these two fields of endeavor.<sup>21</sup> These distinctions are at least as compelling as, if not more so, than those cited by the courts in *Clay* and *Horn*. Since the reference is directed to a different purpose than the claimed invention, one of ordinary skill in the art "would accordingly have had less motivation or occasion to consider it".<sup>22</sup>

Indeed, the discussion in *Clay* is pertinent to the present case. In addressing the first part of the test for analogous art, the Federal Circuit reasoned:

*The PTO argues that [the reference] and [Applicant's] inventions are part of a common endeavor—"maximizing withdrawal of petroleum stored in petroleum reservoirs." However, [the reference] cannot be considered to be within [Applicant's] field of endeavor merely because both relate to the petroleum industry. ...[Applicant's] field of endeavor is the **storage** of refined liquid hydrocarbons. The field of endeavor of the [reference], on the other hand, is the **extraction** of crude petroleum. The Board clearly erred in considering [the reference] to be within the same field of endeavor as [Applicant's].<sup>23</sup>*

This reasoning reads directly on the present case with only slight modification for the technologies involved. With respect to the second part of the test, the Federal Circuit, after a discussion of the two inventions, held:

*A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation*

---

<sup>20</sup> Waggoner, p. 1, ll. 39-42.

<sup>21</sup> See *Clay*, 23 U.S.P.Q.2d (BNA) at 1060-61; *In re Horn*, 203 U.S.P.Q. (BNA)969, 971 (C.C.P.A. 1979).

<sup>22</sup> *Clay*, 23 U.S.P.Q.2d (BNA) 1061.

<sup>23</sup> *Clay*, 23 U.S.P.Q.2d (BNA) at 1060.

*anomalies. The Board's finding to the contrary is clearly erroneous.*<sup>24</sup>

Again, with some modification for the involved technologies, the reasoning applies directly to the present case. Waggoner is outside the scope and content of the prior art applicable to Applicant's invention. For at least this additional reason, claims 9-12, 20, and 24-26 are allowable over Waggoner in view of Rankin.

**3. If Waggoner and Rankin were to be combined, the result would not be Applicant's claimed invention**

Even if Waggoner and Rankin were to be combined, the result would not be the invention of claims 9-12, 20, and 24-26. Rather, if a person having ordinary skill in the art at the time of the invention would have combined Waggoner and Rankin, the result would be a *linoleum jacket* having discs 13 and tongues 15 that were removable from sheet member 6. Thus, the combination of Waggoner and Rankin cannot render the invention set forth in claims 9-12, 20, and 24-26 obvious.

For at least these reasons, it is respectfully requested that the rejection of claims 9-12, 20, and 24-26 under 35 USC § 103(a), as being unpatentable over Waggoner in view of Rankin, be reconsidered and withdrawn.

**B. CLAIM 13 IS ALLOWABLE OVER WAGGONER IN VIEW OF RANKIN AND BERGMAN**

Claim 13 stands rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Rankin and Bergman. This rejection is respectfully traversed because (1) Waggoner fails to disclose or suggest the claimed limitations alleged by the Office; (2) Waggoner and Bergman are outside the scope and content of the prior art;

---

<sup>24</sup> *Clay*, 23 U.S.P.Q.2d (BNA) at 1061.

and (3) even if Waggoner, Rankin, and Bergman were to be combined, the result would not be Applicant's claimed invention.

**1. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container**

Claim 13 depends from independent claim 7. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container, as discussed above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26. Waggoner is completely silent with regard to any insulating properties of its linoleum jacket. Waggoner fails to even suggest the desirability of its linoleum jacket having insulating properties. Thus, irrespective of the teaching of Rankin and Bergman, claim 13 is allowable over Waggoner in view of Rankin and Bergman for at least these same reasons.

**2. Waggoner and Bergman are outside the scope and content of the prior art**

The discussion above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26 present reasons why Waggoner is outside the scope and content of the prior art. These same reasons apply equally to claim 13. Bergman is also outside the scope and content of the prior art. The discussion above concerning *Clay* and *Horn* is pertinent to Bergman. Bergman "relates to holding vessels"<sup>25</sup> as opposed to any kind of apparatus for insulating a beverage container. Thus, Bergman can only be within the scope and content of the prior art if it is "reasonably pertinent" to Applicant's invention. In the present case, the hand-held vessel of Bergman "which allows the user to carry or

hold the container without the user contacting the fluid therein”, especially “when the fluid is toxic or hazardous to a person’s skin”<sup>26</sup> addresses a very different problem for a very different purpose. None of these are even remote considerations in Applicant’s invention.

Thus, claim 13 is allowable over Waggoner, Rankin, and Bergman, irrespective of the teaching of Rankin.

**3. Even if Waggoner, Rankin, and Bergman were to be combined, the result would not be Applicant’s claimed invention**

Even if Waggoner, Rankin, and Bergman were to be combined, the result would not be the invention of claim 13. Rather, if a person having ordinary skill in the art at the time of the invention would have combined Waggoner, Rankin, and Bergman, the result would be a linoleum jacket having discs 13, having grooves, and tongues 15 that were removable from sheet member 6. Thus, the combination of Waggoner, Rankin, and Bergman cannot render the present invention set forth in claim 13 obvious.

For at least these reasons, it is respectfully requested that the rejection of claim 13 under 35 USC § 103(a), as being unpatentable over Waggoner, Rankin, and Bergman, be reconsidered and withdrawn.

**C. CLAIM 14 IS ALLOWABLE OVER WAGGONER IN VIEW OF ALLEN**

Claim 14 stands rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Allen. This rejection is respectfully traversed because (1) Waggoner fails to disclose or suggest the claimed limitations alleged by the Office; (2)

---

<sup>25</sup> Bergman, ¶ [0001].

<sup>26</sup> Bergman, ¶ [0002].

Waggoner and Allen are outside the scope and content of the prior art; (3) the prior art fails to provide motivation to a person having ordinary skill in the art at the time of the invention to modify Waggoner; and (4) even if Waggoner and Allen were to be combined, the result would not be Applicant's claimed invention.

**1. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container**

Claim 14 depends from independent claim 7. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container, for the same reasons set forth above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26. Thus, irrespective of the teaching of Allen, claim 14 is allowable over Waggoner in view of Allen.

**2. Waggoner and Allen are outside the scope and content of the prior art**

The discussion above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26 present reasons why Waggoner is outside the scope and content of the prior art. These same reasons apply equally to claim 14. Thus, irrespective of the teaching of Allen, claim 14 is allowable over Waggoner and Allen. Allen is also outside the scope and content of the prior art. The discussion above concerning *Clay and Horn* is pertinent to Allen. Allen relates to "conforming shoe construction"<sup>27</sup> as opposed to any kind of apparatus for insulating a beverage container. Thus, Allen can only be within the scope and content of the prior art if it is "reasonably pertinent" to Applicant's invention. In the present case, the "conforming medium containing gels for customized



fitting components, such as those used in a shoe”<sup>28</sup> addresses a very different problem for a very different purpose. None of these are even remote considerations in Applicant’s invention. Thus, claim 14 is allowable over Waggoner and Allen.

**3. The prior art fails to provide motivation to a person having ordinary skill in the art at the time of the invention to modify Waggoner**

The Office alleges that “[i]t would have been obvious to add the pull tab to enhance the grip on the tongue.”<sup>29</sup> The question remains, however, why would a person having ordinary skill in the art at the time of the invention have appreciated that such an “enhancement” would be desirable? Why would a person having ordinary skill in the art at the time of the invention have appreciated that the tongues 15 of Waggoner would benefit from such pull tabs? Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would not have been so motivated. What purpose would the pull tabs of Allen serve, when the tongues 15 of Waggoner are pulled with cord 16?

Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would not have been motivated to combine Waggoner and Allen. Accordingly, for this additional reason, claim 14 is allowable over Waggoner and Allen.

**4. Even if Waggoner and Allen were to be combined, the result would not be Applicant’s claimed invention**

Even if Waggoner and Allen were to be combined, the result would not be the invention of claim 14. Rather, if a person having ordinary skill in the art at the time of the invention would have combined Waggoner and Allen, the result would be a

---

<sup>27</sup> Allen, Title.

<sup>28</sup> Allen, col. 1, ll. 13-15.

**linoleum jacket** having tongues 15 with pull tabs. Thus, the combination of Waggoner and Allen cannot render the present invention set forth in claim 14 obvious.

For at least these reasons, it is respectfully requested that the rejection of claim 14 under 35 USC § 103(a), as being unpatentable over Waggoner and Allen, be reconsidered and withdrawn.

#### **D. CLAIM 15 IS ALLOWABLE OVER WAGGONER IN VIEW OF DUNCAN**

Claim 15 stands rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Duncan. This rejection is respectfully traversed because (1) Waggoner fails to disclose or suggest the claimed limitations alleged by the Office; (2) Waggoner and Duncan are outside the scope and content of the prior art; and (3) even if Waggoner and Duncan were to be combined, the result would not be Applicant's claimed invention.

##### **1. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container**

Claim 15 depends from independent claim 7. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container, for the same reasons set forth above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26. Thus, irrespective of the teaching of Duncan, claim 15 is allowable over Waggoner in view of Duncan.

---

<sup>29</sup> Detailed Action, p. 4, ll. 2-3.

## **2. Waggoner and Duncan are outside the scope and content of the prior art**

The discussion above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26 present reasons why Waggoner is outside the scope and content of the prior art. These same reasons apply equally to claim 15. Thus, irrespective of the teaching of Duncan, claim 15 is allowable over Waggoner and Duncan. Duncan is also outside the scope and content of the prior art. The discussion above concerning *Clay* and *Horn* is pertinent to Duncan. Duncan relates to “portable gas generators”<sup>30</sup> as opposed to any kind of apparatus for insulating a beverage container. Thus, Duncan can only be within the scope and content of the prior art if it is “reasonably pertinent” to Applicant’s invention. In the present case, the “insulating blanket or cozy for [portable acetylene gas generating tanks], the ***express purpose being to prevent freezing of the liquid within the tank***,”<sup>31</sup> (emphasis added) addresses a very different problem for a very different purpose. None of these are even remote considerations in Applicant’s invention. Thus, claim 15 is allowable over Waggoner and Duncan.

## **3. Even if Waggoner and Duncan were to be combined, the result would not be Applicant’s claimed invention**

Even if Waggoner and Duncan were to be combined, the result would not be the invention of claim 15. Rather, if a person having ordinary skill in the art at the time of the invention would have combined Waggoner and Duncan, the result would be a ***linoleum jacket*** having eyelets. Thus, the combination of Waggoner, Rankin, and Bergman cannot render the present invention set forth in claim 15 obvious.

---

<sup>30</sup> Duncan, p. 1, ll. 11-12.

<sup>31</sup> Allen, col. 1, ll. 13-15.

For at least these reasons, it is respectfully requested that the rejection of claim 15 under 35 USC § 103(a), as being unpatentable over Waggoner and Duncan, be reconsidered and withdrawn.

**E. CLAIMS 16 AND 17 ARE ALLOWABLE OVER WAGGONER IN VIEW OF DUNCAN AND LIU**

Claims 16 and 17 stand rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Duncan and Liu. This rejection is respectfully traversed because (1) Waggoner fails to disclose or suggest the claimed limitations alleged by the Office; (2) Waggoner, Duncan, and Liu are outside the scope and content of the prior art; and (3) even if Waggoner, Duncan, and Liu were to be combined, the result would not be Applicant's claimed invention.

**1. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container**

Claims 16 and 17 depends from independent claim 7. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container, for the same reasons set forth above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26. Thus, irrespective of the teaching of Duncan and Liu, claims 16 and 17 are allowable over Waggoner in view of Duncan and Liu.

**2. Waggoner, Duncan, and Liu are outside the scope and content of the prior art**

The discussion above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26 presents reasons why Waggoner is outside the scope and content of the prior art. The discussion above concerning the 35 USC § 103(a) rejection of claim 15

presents reasons why Duncan is outside the scope and content of the prior art. These same reasons apply equally to claims 16 and 17. Thus, irrespective of the teaching of Liu, claims 16 and 17 are allowable over Waggoner and Duncan. Liu is also outside the scope and content of the prior art. The discussion above concerning *Clay* and *Horn* is pertinent to Liu. Liu relates to “a shoe”<sup>32</sup> as opposed to any kind of apparatus for insulating a beverage container. Thus, Liu can only be within the scope and content of the prior art if it is “reasonably pertinent” to Applicant’s invention. In the present case, the “shoe having a shoe lace device ***that can be tightened to simulate a double-bow knot***,”<sup>33</sup> (emphasis added) addresses a very different problem for a very different purpose. None of these are even remote considerations in Applicant’s invention. Thus, claims 16 and 17 are allowable over Waggoner, Duncan, and Liu.

**3. Even if Waggoner, Duncan, and Liu were to be combined, the result would not be Applicant’s claimed invention**

Even if Waggoner, Duncan, and Liu were to be combined, the result would not be the invention of claims 16 and 17. Rather, if a person having ordinary skill in the art at the time of the invention would have combined Waggoner, Duncan, and Liu, the result would be a ***linoleum jacket*** having eyelets. Clamp 20 of Liu would be used to retain cord 16 of Waggoner. Thus, the combination of Waggoner, Duncan, and Liu cannot render the present invention set forth in claims 16 and 17 obvious.

For at least these reasons, it is respectfully requested that the rejection of claims 16 and 17 under 35 USC § 103(a), as being unpatentable over Waggoner, Duncan, and Liu, be reconsidered and withdrawn.

---

<sup>32</sup> Liu, col. 1, l. 8.

**F. CLAIMS 21-23 ARE ALLOWABLE OVER WAGGONER IN VIEW OF RANKIN, DUNCAN, LIU, AND ALLEN**

Claims 21-23 stand rejected under 35 USC § 103(a), as being unpatentable over Waggoner in view of Rankin, Duncan, Liu, and Allen. This rejection is respectfully traversed because (1) Waggoner fails to disclose or suggest the claimed limitations alleged by the Office; (2) Waggoner, Rankin, Duncan, Liu, and Allen are outside the scope and content of the prior art; and (3) even if Waggoner, Rankin, Duncan, Liu, and Allen were to be combined, the result would not be Applicant's claimed invention.

**1. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container**

Claims 21-23 depends from independent claim 20. Waggoner fails to disclose or suggest an apparatus for insulating a beverage container or a first portion defining a cavity adapted to receive the beverage container, for the same reasons set forth above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26. Thus, irrespective of the teaching of Rankin, Duncan, Liu, and Allen, claims 21-23 are allowable over Waggoner in view of Rankin Duncan, Liu, and Allen.

**2. Waggoner, Duncan, Liu, and Allen are outside the scope and content of the prior art**

The discussion above concerning the 35 USC § 103(a) rejection of claims 9-12, 20, and 24-26 presents reasons why Waggoner is outside the scope and content of the prior art. The discussion above concerning the 35 USC § 103(a) rejection of claim 15 presents reasons why Duncan is outside the scope and content of the prior art. The

---

<sup>33</sup> Liu, col. 1, ll. 8-10.

discussion above concerning the 35 USC § 103(a) rejection of claims 16 and 17 presents reasons why Liu is outside the scope and content of the prior art. The discussion above concerning the 35 USC § 103(a) rejection of claim 14 presents reasons why Allen is outside the scope and content of the prior art. These same reasons apply equally to claims 21-23. Thus, irrespective of the teaching of Rankin, claims 21-23 are allowable over Waggoner, Rankin, Duncan, Liu and Allen.

**3. Even if Waggoner, Rankin, Duncan, Liu, and Allen were to be combined, the result would not be Applicant's claimed invention**

Even if Waggoner, Rankin, Duncan, Liu, and Allen were to be combined, the result would not be the invention of claims 21-23. Rather, if a person having ordinary skill in the art at the time of the invention would have combined Waggoner, Rankin, Duncan, Liu, and Allen, the result would be a *linoleum jacket* having eyelets and having discs 13 and tongues 15 that were removable from sheet member 6. Clamp 20 of Liu would be used to retain cord 16 of Waggoner. Thus, the combination of Waggoner, Rankin, Duncan, Liu, and Allen cannot render the present invention set forth in claims 21-23 obvious.

For at least these reasons, it is respectfully requested that the rejection of claims 21-23 under 35 USC § 103(a), as being unpatentable over Waggoner, Rankin, Duncan, Liu, and Allen, be reconsidered and withdrawn.


## **CONCLUSION**

Note that Applicant has merely discussed example distinctions from the various references cited by the Office. Other distinctions may exist and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, if such additional statements exist, Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Office's rejections.

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 578-8616 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

11 SEPT 2006  
Date

  
James E. Walton, Reg. No. 47,245  
Michael Alford, Reg. No. 48,707  
Daren C. Davis, Reg. No. 38,425

Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
daren@waltonpllc.com (e-mail)

**CUSTOMER NO. 38441**

**ATTORNEYS AND AGENTS FOR APPLICANT**